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In re Application of
Werner Honegger
Application No. 10/660,783
Filed: September 12, 2003
For: A METHOD AND A DEVICE
FOR PROCESSING AND
SEPARATING AN IMBRICATE
FORMATION OF FLEXIBLE,
FLAT OBJECTS

DECISION ON PETITION
UNDER 37 CFR §1.144

This is a decision on the petition under 37 CFR 1.144 filed November 23, 2007, for review of a Restriction Requirement mailed January 27, 2006.

The petition is **DENIED**.

This application was filed September 12, 2003. After a Preliminary Amendment was entered on June 14, 2004, this application included claims 1-16 directed toward "A method for processing and separating an imbricate formation of flexible, flat objects during product feed", claims 17-25 directed toward "A guide", and claims 26-31 directed toward "Guiding".

On January 27, 2006, the Examiner mailed a Restriction Requirement between Invention I, recited in claims 1-16, Invention II recited in claims 17-25, and Invention III, recited in claims 26-31. The Examiner alleged that: Inventions I and II are related as process and apparatus for its practice; Inventions II and III are related as process and apparatus for its practice; and III and are related as sub-combinations disclosed as usable together in a single combination.

In response to the Restriction Requirement, on August 4, 2006, Petitioner elected Invention I, but traversed the Restriction Requirement alleging that the subject matter of the three groups overlap, there would be no serious burden on the examiner, and the claims of the application define the same essential characteristics of a single disclosed embodiment. On May 30, 2006, the Examiner issued a Non-final Office Action responding to the Petitioner's remarks

by noting that the searches for the subject matter of the three groups is not the same, stating that it would be a serious burden to search for all of the different claimed inventions, and noting the different embodiments in the application. The Examiner also made the Restriction Requirement Final.

On February 20, 2007, in response to the Examiner's Non-final Office Action, the Petitioner filed an amendment cancelling all the existing claims 1-31 in the application and adding new claims 32-62. On May 22, 2007, the Examiner mailed a Final Office Action withdrawing claims 48-62 because those claims correspond to previously presented claims 17-31 drawn to non-elected inventions.

On November 23, 2007, the Petitioner filed a Petition pursuant to 37 C.F.R. § 1.144 for withdrawal of the Restriction Requirement and examination of all claims 32-62. The Petitioner argues that the Restriction Requirement is improper for the following reasons: since the mandatory fields of search for the Inventions overlap and are substantially coextensive there would be no serious burden on the Examiner to examine all the claims; the Examiner has not demonstrated that all the claims could not be examined without serious burden; the claims of the application define the same essential characteristics of a single disclosed embodiment; and the Final Office Action withdrawing claims 48-62 did not provide analysis to support the Examiner's conclusion that those claims were drawn to non-elected inventions.

M.P.E.P. § 803.01 provides the criteria for a proper requirement for restriction between patentably distinct inventions. First, the inventions must be independent or distinct as claimed. Second, there would be a serious burden on the examiner if restriction is not required. M.P.E.P. § 806.05 provides guidance for determining whether or not inventions as claimed are distinct. Specifically, M.P.E.P. § 806.05(d) states, "two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants." Additionally, M.P.E.P. § 806.05(e) states "process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process as claimed can be practiced by another materially different apparatus or by hand; or (B) that the apparatus as claimed can be used to practice another materially different process." M.P.E.P. § provides guidance for determining serious burden. M.P.E.P. § 808.02 states that in order to demonstrate a serious burden, the Examiner must show that the inventions have a separate classification, a separate status in the art when they are classifiable together, or a different field of search. Finally, M.P.E.P. § 814 states, "the examiner must provide a clear and detailed record of the restriction requirement to provide a clear demarcation between restricted inventions so that it can be determined whether inventions claimed in a continuing application are consonant with the restriction requirement and therefore subject to the prohibition against double

patenting rejections under 35 U.S.C. 121." In other words, the restriction requirement must provide guidance for determining whether inventions claimed in a continuing application are consonant with the restriction requirement.

The Restriction Requirement mailed January 27, 2006 demonstrates that the inventions are distinct as claimed. The Requirement states that Inventions I and II are related as process and apparatus for its practice and illustrates how the process as claimed can be practice by another materially different apparatus. The Requirement states that Inventions II and III are related as process and apparatus for its practice and illustrates how the apparatus as claimed can be used to practice another materially different process. Finally, the Requirement states that Inventions III and I are related as subcombinations disclosed as usable together in a single combination and illustrates how they are separately usable. The claimed inventions are distinct.

The Restriction Requirement mailed January 27, 2006 also demonstrates that there would be a serious burden on the Examiner if restriction is not required. The Requirement states that Invention I is a method for processing classified in class 271, subclass 3.01; Invention II is a guide classified in class 271, subclass 264; and Invention III is a guiding method classified in class 271, subclass 264. The Requirement notes that Invention I has a separate classification than Inventions II and III. The Requirement also notes although Inventions II and III are classifiable together, they have acquired a separate status in the art because of their recognized divergent subject matter. Invention II is drawn to an apparatus and Invention III is drawn to a method or process. Petitioner states that the Examiner has not demonstrated that there would be a serious burden to examine all three inventions and a comprehensive search for all the inventions overlaps. However, the Examiner has demonstrated that the criteria for demonstrating serious burden as outlined in M.P.E.P. § 808.02. It would be a serious burden on the Examiner if restriction is not required.

Petitioner states that the application discloses only one embodiment and the claims are merely very broad in scope. However, pages 14 -15 of the specification of the application discuss at least five different embodiments. As such, it cannot be concluded that the claims of this application define the same essential characteristics of a single disclosed embodiment of the invention.

The Restriction Requirement mailed January 27, 2006 provides a clear and detailed record. Based on the Requirement, it can be determined whether inventions claimed in a continuing application are consonant with the restriction requirement. Invention I includes those claims drawn to a method for processing and separating imbricate formation of flexible flat objects; Invention II includes those claims drawn to a guide; and Invention III includes those claims drawn to a guiding method. During prosecution of this application, Petitioner cancelled all the original claims 1-31 and added new claims 32-62. In response to Petitioner's

amendment, the Examiner indicated that claims 48-62 were directed toward the non-elected inventions and withdrew them from further consideration. Petitioner states that the Examiner provided no analysis to support withdrawing newly added claims 48-62 as directed to non-elected inventions. However, newly added claims 32-47 are directed toward a method for processing and separating flexible flat objects which is Invention I as outlined in the Restriction Requirement. Also, newly added claims 48-56 are directed toward a guide which is Invention II as outlined in the Restriction Requirement. Finally, claims 57-62 are directed toward a guiding method which is Invention III as outlined in the Restriction Requirement. Therefore, claims consonant with the restriction requirement can be determined. The Restriction Requirement is clear.

For the foregoing reasons, the Restriction Requirement mailed January 27, 2006 and the withdrawal of newly added claims 48-62 are proper.

This application is being forwarded to the examiner of record to continue prosecution.

Any questions regarding this Decision should be directed to Patrick Mackey at (571) 272-6916.



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Pm/snm: 2/3/09

